



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,102	01/19/2001	Martin Thomas	10191/1663	8931

26646 7590 12/21/2004

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

BAUM, RONALD

ART UNIT PAPER NUMBER

2136

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 09/766,102	Applicant(s) THOMAS ET AL	
	Examiner Ronald Baum	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. This action is in reply to applicant's correspondence of 27 September 2004.
2. Claims 1-16 are pending for examination.
3. Claims 1-16 remain rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Mirov et al, U.S. Patent 6,138,236.
5. As per claim 1; "A method for protecting a microcomputer system from manipulation of data stored in a storage arrangement of the microcomputer system, the microcomputer system including a microcomputer allocated to the storage arrangement [Abstract, figure 1 and accompanying description, col. 1, lines 13-col. 2, line 4], comprising the steps of: causing the microcomputer to access the storage arrangement for processing the data [Abstract, figure 1 and accompanying description, col. 1, lines 13-col. 2, line 4, col. 2, lines 7-63]; and before the storage arrangement is accessed, performing the steps of: assigning an individual identifier to one of the allocated microcomputer and the storage arrangement, generating a comparison code and storing the comparison code in the storage arrangement as a function of the individual identifier

Art Unit: 2136

[Abstract, figure 1 and accompanying description, col. 1, lines 13-col. 2, line 4, col. 2, lines 7-63], and at a time that is one of before and during an operation of the microcomputer system, generating a security code as a function of the individual identifier and comparing the security code with the comparison code [Abstract, figure 1, 3, 4 and accompanying descriptions, col. 1, lines 13-col. 2, line 4, col. 2, lines 7-63].”;

Further, as per claim 10; “A storage arrangement [This claim is the system claim for the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection] in which data are stored and to which is allocated at least one microcomputer that accesses the storage arrangement for processing the data, comprising: an arrangement for storing a comparison code that is generated as a function of an individual identifier assigned to one of the at least one microcomputer and the storage arrangement; and an arrangement for, at a time that is one of before and during an operation of the storage arrangement, generating a security code as a function of the individual identifier and for comparing the security code with the comparison code.”;

Further, as per claim 14; “A microcomputer system [This claim is the system claim for the method claim 1 above, and is rejected for the same reasons provided for the claim 1 rejection], comprising: a microcomputer; and a storage arrangement assigned to the microcomputer, wherein: data are stored in the storage arrangement, the microcomputer accesses the storage arrangement in order to process the data, in the storage arrangement, a comparison code that is generated as a function of an individual identifier assigned to one of the microcomputer and to the storage arrangement is stored, and the microcomputer includes an arrangement for, at a time that is one of before and during an operation of the microcomputer

Art Unit: 2136

system, for generating a security code as a function of the individual identifier and to compare the security code with the comparison code.”.

6. Claim 2 *additionally recites* the limitation that; “The method according to claim 1, wherein: the data corresponds to a program.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, whereas the “plurality of micro code” is clearly a stored program);

Further, as per claim 11 *additionally reciting* the limitation that; “The storage arrangement [This claim is the system claim for the method claim 2 above, and is rejected for the same reasons provided for the claim 2 rejection] according to claim 10, wherein: the data correspond to a program.”;

Further, as per claim 15 *additionally reciting* the limitation that; “The microcomputer [This claim is the system claim for the method claim 2 above, and is rejected for the same reasons provided for the claim 2 rejection] according to claim 14, wherein: the data correspond to a program.”.

7. Claim 3 *additionally recites* the limitation that; “The method according to claim 1, wherein: a program stored in the storage arrangement is protected.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, whereas the “security sensitive environments require that the micro code be tamper proof...” clearly constitutes a protected stored program).

Art Unit: 2136

8. Claim 4 *additionally recites* the limitation that; “The method according to claim 1, wherein before the storage arrangement is accessed, the method further comprises the steps of: storing the individual identifier as the comparison code in the storage arrangement; and at the time that is one of before and during the operation of the microcomputer system, performing a check as to whether the comparison code agrees with the individual identifier, used as the security code, of the allocated microcomputer.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, col. 5,line 51-col. 8,line 26, whereas the public key encryption oriented digital signature clearly constitutes an individual identifier as the comparison code).

9. Claim 5 *additionally recites* the limitation that; “The method according to claim 1, wherein: the storage arrangement normally cooperates with the allocated microcomputer only when the security code agrees with the comparison code.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, col. 5,line 51-col. 8,line 26, whereas the public key encryption oriented digital signature comparison success allows for the boot-up process to continue such that “...the trust level of the unsecured micro-code is raised to a level of trusted, other boot data such as the boot blocks of the disk drive...” , and thereby clearly constitutes the storage arrangement cooperating with the allocated microcomputer when the security code agrees with the comparison code).

Art Unit: 2136

10. Claim 6 *additionally recites* the limitation that; “The method according to claim 1, wherein: before an operation of the storage arrangement, after every start-up of the storage arrangement, the security code is generated and is compared with the comparison code.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, col. 5,line 51-col. 8,line 26, whereas the public key encryption oriented digital signature comparison success allows for the boot-up process to continue such that “...the trust level of the unsecured micro-code is raised to a level of trusted, other boot data such as the boot blocks of the disk drive...” , and thereby clearly constitutes the storage arrangement cooperating with the allocated microcomputer when the security code agrees with the comparison code, again, throughout the memory access functions during “start-up of the storage arrangement”).

11. Claim 7 *additionally recites* the limitation that; “The method according to claim 6, further comprising the step of: placing the storage arrangement in a mode in which, after every start-up, the storage arrangement is switched from an inactive state to an active state only when the security code agrees with the comparison code.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, col. 5,line 51-col. 8,line 26, whereas the public key encryption oriented digital signature comparison success allows for the boot-up process to continue such that “...the trust level of the unsecured micro-code is raised to a level of trusted, other boot data such as the boot blocks of the disk drive...” , and thereby clearly constitutes the storage arrangement cooperating

Art Unit: 2136

with the allocated microcomputer when the security code agrees with the comparison code, again, throughout the memory access functions during “start-up of the storage arrangement”.);

Further, as per claim 12 *additionally reciting* the limitation that; “The storage arrangement [This claim is the system claim for the method claim 7 above, and is rejected for the same reasons provided for the claim 7 rejection] according to claim 10, wherein: the storage arrangement is capable of being, placed in a mode in which, after every start-up, the storage arrangement is switched from an inactive state to an active state only when the security code agrees with the comparison code.”;

Further, as per claim 16 *additionally reciting* the limitation that; “The microcomputer [This claim is the system claim for the method claim 7 above, and is rejected for the same reasons provided for the claim 7 rejection] according to claim 14, wherein: the microcomputer is capable of being placed in a mode in which, after every start-up, the microcomputer is switched from an inactive state to an active state only when the security code agrees with the comparison code.”.

12. Claim 8 *additionally recites* the limitation that; “The method according to claim 6, further comprising the step of: placing the allocated microcomputer in a mode in which, after every start-up, the allocated in microcomputer is switched from an inactive to an active state only when the security code agrees with the comparison code.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, col. 5,line 51-col. 8,line 26, whereas the public key encryption oriented digital signature comparison success allows for the boot-up process to continue such that “...the

Art Unit: 2136

trust level of the unsecured micro-code is raised to a level of trusted, other boot data such as the boot blocks of the disk drive...” , and thereby clearly constitutes the storage arrangement cooperating with the allocated microcomputer when the security code agrees with the comparison code, again, throughout the memory access functions during “start-up of the storage arrangement”).

13. Claim 9 *additionally recites* the limitation that; “The method according to claim 1, further comprising the steps of: executing a validation program stored in a read-only memory of the allocated microcomputer; determining a code word in the validation program from at least one part of a memory content of the storage arrangement in accordance with a key; and comparing the code word with a comparison code word stored in the storage arrangement.”. The teachings of Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, col. 5,line 51-col. 8,line 26, whereas the public key encryption oriented digital signature comparison success allows for the boot-up process to continue such that “...the trust level of the unsecured micro-code is raised to a level of trusted, other boot data such as the boot blocks of the disk drive...” , and thereby clearly constitutes the storage arrangement cooperating with the allocated microcomputer when the security code agrees with the comparison code, again, throughout the memory access functions during “start-up of the storage arrangement”).

14. Claim 13 *additionally recites* the limitation that; “The storage arrangement according to claim 10, wherein: the storage arrangement corresponds to a flash memory.”. The teachings of

Art Unit: 2136

Mirov et al suggest such limitations (Abstract, figure 1,3,4 and accompanying descriptions, col. 1,lines 13-col. 2,line 4, col. 2,lines 7-63, whereas the "... flash PROM is divided into two main sections..." is clearly a storage arrangement corresponding to a flash memory.).

Response to Amendment

15. As per applicant's argument concerning the lack of teaching of security and comparison codes, both a function of the same individual identifier, the examiner has fully considered the arguments and finds them not to be persuasive. The firmware authentication prior to re-execution via a upgrade of same clearly encompasses the '... protecting a microcomputer system from manipulation of data stored in a storage arrangement of the microcomputer system...' [i.e., Abstract, col. 2,lines 7-33], as broadly interpreted by the examiner. Further, the predetermined digital signature clearly does corresponds to the applicant's use of the comparison code, as broadly interpreted by the examiner, in that the signature is pre-generated prior to access, and is clearly individualized relative to the memory signature (i.e., a unique checksum aspect of the memory arrangement would be inherent given a unique key and memory configuration per se.). The data and verification hash comparison clearly as part of the authentication process to run (any) software, let alone the upgraded software (i.e., the new firmware), again, clearly as broadly interpreted by the examiner, encompasses the teaching of the code comparison aspects of the claim limitation language. The claim language specifically dealing with the phrase 'individual identifier' is sufficiently broad such that checksums, memory individuality aspects of signature/hash considerations, would therefore be applicable in the rejection.

Art Unit: 2136

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

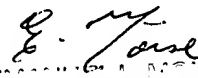
Conclusion

17. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (571) 272-3681, and whose unofficial Fax number is (571) 273-3681. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The Fax number for the organization where this application is assigned is 703-872-9306.

Ronald Baum

Patent Examiner


RONALD BAUM
PATENT EXAMINER

Art Unit: 2136